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09/872,451

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Robert Lennie

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EXAMINER

SIDDIQI, MOHAMMAD A

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/872,451	Applicant(s) LENNIE ET AL.	
	Examiner MOHAMMAD A. SIDDIQI	Art Unit 2454	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11-22, 24-28 and 30-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-22, 24-28, and 30-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-9, 11-22, 24-28, and 30-33 are presented for examination. Claims 10, 23, and 29 has been cancelled.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-9, 11-22, 24-28, and 30-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe et al. (6,850,757) (hereinafter Watanabe) in view of Mousseau et al. (US PUB 2002/0120696) (hereinafter Mousseau).

4. As per claims 1 and 27, Watanabe discloses a communication system and method for pushing electronic messages to a wireless portable device (arrival notification message is pushed by notification apparatus, col 2, lines 54-60; col 5, lines 6-31) to advise a user when an electronic message is received and to provide the user with a subset of the electronic message to allow the user to download electronic message of interest for viewing at the wireless portable device (col 2, lines 54-60; col 5,

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lines 6-31), comprising: a mail server (102, fig 1) having an electronic mail interface configured to be coupled to the internet (104, fig 1, col 2, lines 48-60), for storing an electronic mail message received over the Internet (col 2, lines 37-60) and for generating a copy of said electronic mail message (Fig 1, col 2, lines 24-46);

a notifications server (100, fig 1, col 2, lines 24-36), coupled to said mail server (col 2, lines 24-36), and having a standard electronic mail protocol for automatically receiving said copy of said electronic mail message as a standard formatted electronic mail message (100, fig 1, col 2, lines 24-53);

wherein said mail server (102, fig 1) automatically forwards using standard mail protocols the copies of the received messages to the said notification server (100, fig 1, col 2, lines 27-60);

wherein said notifications server (100, fig 1, col 2, lines 24-60) is for automatically generating (arrival notification mail, col 2, lines 24-60), therefrom, a subset of said received copy of said electronic mail message (col 5, lines 6-31); and

wherein said notifications server (col 2, lines 24-60), upon generation of said subset (subset is interpreted as message, col 5, lines 6-31), is configured to automatically transmit without any user trigger (notification, col 1, lines 5-10; col 2, lines 54-67) said subset (subset is interpreted as message, col 3, lines 33-35) to an identified wireless electronic device (col 5, lines 6-31) associated with a user that is the recipient of said received electronic mail message (cellular phone, col 5, lines 6-39), and wherein the user subsequently is able to select the subset (subset is interpreted as body of the

text, col 6, lines 18-33) and thereby download the remainder of the electronic mail message (col 6, lines 17-44).

The "prior art" (or "the system of") of Watanabe teaches notification apparatus (100, fig 1,) generating and notifying arrival of notification mail message to the wireless device (col 2, lines 24-60) and further suggest adding couple of short sentences to the notification message (col 5, lines 22-31). Watanabe does not specifically disclose generating a copy of said electronic mail message, therefrom, a subset of said received copy of said electronic mail message, wherein said mail server automatically forwards using standard mail protocols the copies of the received messages to the said notification server. However, the Watanabe teaches notification apparatus (100, fig 1,) generating and notifying arrival of notification mail message to the wireless device (col 2, lines 24-60) and further suggest adding couple of short sentences to the notification message (col 5, lines 22-31). Mousseau generating a copy of said electronic mail message (page 7, paragraph #0070; page 8, paragraph #0076), therefrom, a subset of said received copy of said electronic mail message (page 7, paragraph #0070; page 8, paragraph #0076; and paragraph #0067). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of Watanabe and Mousseau. The motivation (prior art of Watanabe at least suggests adding a couple of short sentence so user can determine whether the electronic mail should be read, col 5, lines 22-31, col 6, lines 18-33) would have been developing mail arrival notification system for notifying mobile user device extracted information from the original mail

so user of the wireless device can determine whether the electronic mail should be read.

5. As per claim 14, the claim is rejected for the same reasons as claim 1, above. In addition, Watanabe discloses a plurality of wireless electronic devices operable to communicate over a wireless communication network (106, fig 1, col 2, lines 24-60).

6. As per claims 2, 15, and 28, claims are rejected for the same reasons as claim 1, above. In addition, Watanabe discloses said identified wireless electronic device is operable to display received subsets to a user LCD display, (col 5, lines 29-31).

7. As per claims 3, and 16, claims are rejected for the same reasons as claim 1, above. In addition, Watanabe discloses said identified wireless electronic device is operable to allow said user to select a particular received subset and wherein said notifications server is also for transmitting the remainder of an electronic mail message corresponding to said particular received subset in response to the selection thereof by said identified wireless electronic device (col 5, lines 45-67; col 6, lines 18-43).

8. As per claims 4 and 17, claims are rejected for the same reasons as claim 1, above. In addition Mousseau discloses said subset is a notification message comprising a sender's identification and a subject field of said received electronic mail message (page 8, paragraph #0076).

9. As per claims 5 and 18, claims are rejected for the same reasons as claim 1, above. In addition, Watanabe discloses said identified wireless electronic device is a handheld computer system having wirelessly enabled (fig 3, col 3, lines 28-36).

10. As per claims 6, 19, and 31, claims are rejected for the same reasons as claim 1, above. In addition, Watanabe discloses wherein said notifications server comprises a user information database for providing a mapping between wireless electronic devices and their associated electronic mail addresses (fig 3, col 3, lines 28-36).

11. As per claims 7, 20 and 32, claims are rejected for the same reasons as claim 1, above. In addition, Watanabe discloses a push packet (is used by said notifications server to wirelessly transmit said subset to said identified wireless electronic device (col 5, lines 22-28).

12. As per claims 8 and 21, claims are rejected for the same reasons as claim 1, above. In addition, Watanabe discloses said subset is wirelessly transmitted using a wireless LAN communication network (elements of fig 1).

13. As per claims 9 and 22, claims are rejected for the same reasons as claim 1, above. In addition Mousseau discloses, using a short range wireless communication network (page 22, paragraph #0174).

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14. As per claims 11, 24, and 33, claims are rejected for the same reasons as claim 1, above. In addition Mousseau discloses said standard electronic mail protocol is substantially compliant with the SMTP protocol (page 9, paragraph #0084).

15. As per claims 12 and 25, claims are rejected for the same reasons as claim 1, above. In addition Mousseau discloses POP protocol (page 9, paragraph #0084).

16. As per claims 13 and 26, claims are rejected for the same reasons as claim 1, above. In addition Mousseau discloses IMAP protocol (page 9, paragraph #0084).

17. As per claim 30, claims are rejected for the same reasons as claim 1, above. In addition, Watanabe discloses said identified wireless electronic device allowing said user to select a particular received notification message including the subset (col 5, lines 22-67; col 6, lines 18-43); and said notifications server transmitting the remainder of an electronic mail message corresponding to said particular received notification message in response to said user selecting said particular received notification message (col 5, lines 45-67; col 6, lines 18-43).

Response to Arguments

18. Applicant's arguments filed 01/27/2009 have been fully considered but they are not persuasive, therefore a rejection to claims 1-9, 11-22, 24-28, and 30-33 is maintained.

19. In response to applicant's argument that Prior art "TEACHES AWAY", A reference is no less anticipatory if, after disclosing the invention, the reference then disparages it. The question whether a reference "teaches away" from the invention is inapplicable to an anticipation analysis. *Celeritas Technologies Ltd. v. Rockwell International Corp.*, 150 F.3d 1354, 1361, 47 USPQ2d 1516, 1522-23 (Fed. Cir. 1998) (The prior art was held to anticipate the claims even though it taught away from the claimed invention. "The fact that a modem with a single carrier data signal is shown to be less than optimal does not vitiate the fact that it is disclosed."). >See *Upsher-Smith Labs. v. Pamlab, LLC*, 412 F.3d 1319, 1323, 75 USPQ2d 1213, 1215 (Fed. Cir. 2005) (claimed composition that expressly excluded an ingredient held anticipated by reference composition that optionally included that same ingredient) ;< see also *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1349, 51 USPQ2d 1943, 1948 (Fed. Cir. 1999) (Claimed composition was anticipated by prior art reference that inherently met claim limitation of "sufficient aeration" even though reference taught away from air entrapment or purposeful aeration.). *Watanabe* discloses a mail server (102, fig 1) having an electronic mail interface configured to be coupled to the internet (104, fig 1,

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col 2, lines 48-60), for storing an electronic mail message received over the Internet (col 2, lines 37-60) and for generating a copy of said electronic mail message (Fig 1, col 2, lines 24-46); a notifications server (100, fig 1, col 2, lines 24-36), coupled to said mail server (col 2, lines 24-36), and having a standard electronic mail protocol for automatically receiving said copy of said electronic mail message as a standard formatted electronic mail message (100, fig 1, col 2, lines 24-53); wherein said mail server (102, fig 1) automatically forwards using standard mail protocols the copies of the received messages to the said notification server (100, fig 1, col 2, lines 27-60); wherein said notifications server (100, fig 1, col 2, lines 24-60) is for automatically generating (arrival notification mail, col 2, lines 24-60), therefrom, a subset of said received copy of said electronic mail message (col 5, lines 6-31); and wherein said notifications server (col 2, lines 24-60), upon generation of said subset (subset is interpreted as message, col 5, lines 6-31), is configured to automatically transmit without any user trigger (notification, col 1, lines 5-10; col 2, lines 54-67) said subset (subset is interpreted as message, col 3, lines 33-35) to an identified wireless electronic device (col 5, lines 6-31) associated with a user that is the recipient of said received electronic mail message (cellular phone, col 5, lines 6-39), and wherein the user subsequently is able to select the subset (subset is interpreted as body of the text, col 6, lines 18-33) and thereby download the remainder of the electronic mail message (col 6, lines 17-44).

The "prior art" (or "the system of") of Watanabe teaches notification apparatus (100, fig 1,) generating and notifying arrival of notification mail message to the wireless device (col 2, lines 24-60) and further suggest adding couple of short sentences to

the notification message (col 5, lines 22-31). Watanabe does not specifically disclose generating a copy of said electronic mail message, therefrom, a subset of said received copy of said electronic mail message, wherein said mail server automatically forwards using standard mail protocols the copies of the received messages to the said notification server. Mousseau generating a copy of said electronic mail message (page 7, paragraph #0070; page 8, paragraph #0076), therefrom, a subset of said received copy of said electronic mail message (page 7, paragraph #0070; page 8, paragraph #0076; and paragraph #0067). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of Watanabe and Mousseau. The motivation (prior art of Watanabe at least suggests adding a couple of short sentence so user can determine whether the electronic mail should be read, col 5, lines 22-31, col 6, lines 18-33) would have been developing mail arrival notification system for notifying mobile user device extracted information from the original mail so user of the wireless device can determine whether the electronic mail should be read.

20. In response applicant argued that:

Argument: Watanabe does not wherein said notifications server, upon generation of said subset, is configured to automatically transmit without any user trigger said subset to an identified wireless electronic device associated with a user that is the recipient of said received electronic mail message, and wherein the user

subsequently is able to select the subset and thereby download the remainder of the electronic mail message.

Response: Watanabe disclose a notifications server (col 2, lines 24-60), upon generation of said subset (subset is interpreted as message, col 5, lines 6-31), is configured to automatically transmit without any user trigger (notification, col 1, lines 5-10; col 2, lines 54-67) said subset (subset is interpreted as message, col 3, lines 33-35) to an identified wireless electronic device (col 5, lines 6-31) associated with a user that is the recipient of said received electronic mail message (cellular phone, col 5, lines 6-39), and wherein the user subsequently is able to select the subset (subset is interpreted as body of the text, col 6, lines 18-33) and thereby download the remainder of the electronic mail message (col 6, lines 17-44).

Note: The court held that broadly providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art.

21. In general, Applicant's arguments reflect a difference of opinion over the teachings of the prior art and how these teachings would be evaluated in light of the knowledge generally available to those in the appropriate art and the level of ordinary skill in the art. Moreover, Applicant's take an overly narrow view of the claim language. Applicant's arguments amounts to a general allegation (pages 10-12) that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Conclusion

22. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MOHAMMAD A. SIDDIQI whose telephone number is (571)272-3976. The examiner can normally be reached on Monday -Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan J. Flynn can be reached on (571) 272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MS

***/Nathan J. Flynn/
Supervisory Patent Examiner, Art Unit 2454***